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**THIS DISPOSITION
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Paper No. 46
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Moscow Distillery Cristall
v.
Simex, Aussenhandelsgesellschaft Savelsberg KG

Opposition No. 99,405
to Application No. 74/132,262
filed on January 22, 1991

Philip J. Moy, Jr. of Fay, Sharpe, Fagan, Minnich & McKee
and David L. Garrison of Garrison and Evans for Moscow
Distillery Cristall.

Jonathan E. Moskin and Charlotta C. Meder of Pennie &
Edmonds for Simex, Aussenhandelsgesellschaft Savelsberg KG.

Before Simms, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Moscow Distillery Cristall ("opposer") has opposed the
application of Simex, Aussenhandelsgesellschaft Savelsberg
KG ("applicant") to register MOSKOVSKAYA CRISTALL and
design, depicted below, for "vodka originating in
Russia."^{1[1]}

^{1[1]} Application Serial No. 74/132,262, filed January 22, 1991, based on
a bona fide intention to use the mark in commerce, pursuant to Section
1(b) of the Trademark Act, and asserting a claim of priority, pursuant

The Pleadings

In its amended notice of opposition, opposer makes various allegations, asserting various purported grounds under the Paris Convention. Opposer also refers to "false assertions" regarding ownership of its mark made by applicant in its application. However, as applicant points out, the only ground argued by opposer in its brief is likelihood of confusion, under Section 2(d) of the Trademark Act. Considering the record, likelihood of confusion is clearly the only ground of opposition that has been tried in this case. Thus, we find that any other possible grounds that opposer may have asserted in its

to Section 44(d) of the Trademark Act, based on the filing of an application in the Federal Republic of Germany on August 11, 1990. The drawing is lined for the colors gold, green and orange. The English translation of MOSKOVSKAYA CRISTALL is "Crystal of Moscow." The application includes a disclaimer of MOSKOVSKAYA.

^{2[2]} All of the wording except MOSKOVSKAYA CRISTALL has been deleted from the mark by applicant's amendment. The Examining Attorney should ensure that the USPTO records correctly reflect this amendment to the drawing of the mark.

amended notice of opposition have been waived and we determine this opposition only on the ground of likelihood of confusion.^{3[3]}

Regarding likelihood of confusion, opposer makes, *inter alia*, the following allegations in its amended notice of opposition:

- • opposer is the manufacturer and bottler of Russian vodka in Russia and, formerly, in the Soviet Union;
- • opposer is the manufacturer of high-quality Russian vodka that has been sold in the United States under marks including STOLICHNAYA, STOLICHNAYA CRISTALL, CRISTALL, and MOSCOW CRISTALL SIGNATURE SERIES;^{4[4]}
- • opposer "has assigned its United States trademark rights in the trademarks CRISTALL and MOSCOW

^{3[3]} With respect to both opposer's Paris Convention claims and its likelihood of confusion claim, opposer submitted no support for its assertion that opposer's alleged STOLICHNAYA CRISTALL mark is well known in connection with vodka.

^{4[4]} With regard to the mark STOLICHNAYA CRISTALL, opposer makes the following allegations: that "sale of STOLICHNAYA CRISTALL manufactured by [opposer] began in 1989 and continues to this day through PepsiCo and its distributors subject to a recent injunction preventing sale of STOLICHNAYA CRISTALL vodka by PepsiCo after the current inventory is depleted"; that "from 1988 to 1995, STOLICHNAYA CRISTALL brand Russian vodka manufactured by [opposer] has been imported into the United States under the control of PepsiCo, Inc. ("PepsiCo") under an agreement between PepsiCo and Sojuplodoimport ("SPI")"; that SPI formerly was the Soviet state entity through which STOLICHNAYA CRISTALL brand Russian vodka was exported from the Soviet Union; that subsequent to the break up of the Soviet Union, opposer became a private joint stock company that succeeded to the rights of its governmental predecessor, including the relationship with PepsiCo; and that "all Russian vodka sold under the mark STOLICHNAYA CRISTALL until 1994 was manufactured by [opposer]" and "[a]fter 1994, PepsiCo began importing vodka falsely marked with the trademark STOLICHNAYA CRISTALL manufactured by Liviz Distillery in St. Petersburg Russia without authorization of [opposer]."

CRISTALL SIGNATURE SERIES to Cristall, U.S.A., Inc., a corporation of the state of Florida";

- • "MOSKOVSKAYA CRISTALL vodka has been advertised by opposer in international publications indicating Moscow Distillery Cristall as the distiller and bottler thereof, but no sales have yet occurred in the United States";
- • on August 8, 1995, opposer filed an application in the United States to register the mark MOSKOVSKAYA CRISTALL based on Russian Federation Trademark Registration No. 118,137;
- • "[I]n its activities in the manufacture, bottling and sale of premium Russian vodka, [opposer] has used the trade name CRISTALL since at least as early as 1989 and currently uses that trade name in its activities in various areas of the world, including the Russian Federation, Europe and the United States";
- • no Russian distillery or entity other than opposer is authorized by the Russian Federation to distill and sell MOSKOVSKAYA CRISTALL vodka; and
- • "use by [opposer] of its various CRISTALL trademarks since at least as early as 1989 throughout the world is well known."

Regarding applicant, opposer makes the following allegations:

- • since about 1990 applicant has been a German distributor of MOSKOVSKAYA CRISTALL vodka produced by opposer and applicant is "fully aware of the international rights of [opposer] in the trademark MOSKOVSKAYA CRISTALL"; and
- • applicant was not, and knew that it was not, the owner of the mark MOSKOVSKAYA CRISTALL when it filed the application which is the subject of this opposition.

In its answer to the notice of opposition, applicant denies the salient allegations therein and asserts, as affirmative defenses, that the notice of opposition is barred under the principles of abandonment, territoriality of trademarks, estoppel, acquiescence and unclean hands.

The Record

The record consists, in part, of the pleadings and the file of the involved application. In an April 18, 2000 decision, the Board struck some of the evidence submitted by opposer during its testimony period and concluded that opposer's acceptable evidence consists of a photocopy of a certified copy of opposer's Russian registration of a mark including the word CRISTALL for vodka^{5[5]}; and the decision of the Ninth Circuit Court of Appeals (appeal Nos. 96-36,217, 96-36,249 and 96-36,250) affirming the decision in Civil Action No. C95-0226WD in the Western District of Washington, of which the Board took judicial notice.

During its testimony period, applicant submitted by notice of reliance certified copies, with translations, of eight German trademark registrations owned by applicant for

^{5[5]} The mark is not identified in the translation of the certificate. However, the translation includes the statement "[a]ll letters, numbers and words, except for CRISTALL, are not subject to independent legal protection." Thus, we can conclude only that the mark includes the word CRISTALL. Further, this photocopy of a registration certificate and incomplete translation is insufficient, alone, to establish

various marks incorporating the words MOSKOVSKAYA or MOSKOVSKAYA CRISTALL, all for, *inter alia*, vodka.^{6[6]} The oldest of these registrations issued on July 22, 1971. Applicant also submitted by notice of reliance opposer's response to applicant's interrogatory no. 27, wherein opposer states that opposer has not yet begun sales in the United States of MOSKOVSKAYA CRISTALL vodka; a dictionary definition of "crystal"; and copies of third-party registrations and applications for marks including the word "crystal" for various beverages, both alcoholic and non-alcoholic.

During its rebuttal testimony period, opposer submitted copies of newspaper articles^{7[7]}; a printout from the USPTO database indicating the abandonment of the application, owned by PepsiCo, Inc., that was the subject of the civil action noted herein; and certified status and title copies of registrations originally owned by opposer, but assigned to a third party, Cristall U.S.A. Inc.^{8[8]}

opposer's ownership of a CRISTALL mark for vodka in Russia, or to support any Paris Convention claim in relation thereto.

^{6[6]} Applicant also submitted proof of renewal of one of the German registrations.

^{7[7]} Opposer states that the purpose of this evidence is to establish opposer's use of the marks STOLICHNAYA CRISTALL and CRISTALL.

^{8[8]} Registration No. 2,336,937 for the mark CRISTALL for vodka (application filed February 7, 1995 and mark registered April 4, 2000); and Registration No. 2,301,166 for the mark CRISTALL and design for

Applicant has objected to opposer's rebuttal evidence as impermissible rebuttal, adding that the newspaper articles are hearsay with respect to any use by opposer of the mark STOLICHNAYA CRISTALL or of the registered marks owned by Cristall U.S.A. Inc. We sustain applicant's objection and strike the evidence submitted by opposer on rebuttal. Opposer provides no indication of the particular points raised by applicant that opposer intends to rebut with this evidence. We find no clear connection between the evidence submitted and applicant's evidence submitted during its testimony period. Opposer did argue that it submitted the newspaper articles to establish opposer's priority. However, even if we were to consider these articles properly of record, we agree with applicant that the newspaper articles are hearsay with respect to any use by opposer of the marks referenced therein, and, thus, of no probative value for that purpose. Furthermore, the articles make no reference to the named opposer and predate the break-up of the Soviet Union and, thus, could not possibly be probative, alone, of the present ownership of the mark in Russia, the United States or anywhere else in the world.

Both parties filed briefs on the case but a hearing was not requested.

Analysis

While it appears that opposer has been determined in its pursuit of this opposition, opposer has failed to submit evidence establishing any rights in a trademark upon which it can rely to establish its case. We note that, even if we had considered the registrations submitted by opposer on rebuttal, these registrations clearly establish that Cristall U.S.A. Inc., not opposer, owns the two proffered CRISTALL registrations in the United States; and the record is absolutely silent on the nature, if any, of a relationship between opposer and this corporation. Likewise, as the Board previously stated in its decision of February 2, 1997, the decision in the civil action involving opposer herein and PepsiCo, a third party relative to this opposition, establishes ownership in the marks CRISTALL and STOLICHNAYA CRISTALL only between the parties to that proceeding.^{9[9]}

^{9[9]} The Court of Appeals for the Ninth Circuit affirmed the District Court's decision in an unpublished opinion. In that unpublished opinion the Court stated that, in an ownership contest between a manufacturer and distributor, a manufacturer owns a mark presumptively in the absence of a controlling contractual agreement; that there was substantial evidence in the record to support the jury's conclusion that PepsiCo failed to rebut the presumption that Moscow Distillery Cristall owned the CRISTALL mark; but that "[b]alancing the relevant factors, the jury could reasonably have found that either party owned

In view thereof, it is unnecessary, as well as not possible, to consider the question of likelihood of confusion. In conclusion, opposer has failed to meet its burden of proof in this opposition.

Decision: The opposition is dismissed.

the CRISTALL mark [however] we may not substitute our view of which party should prevail for the jury's view."